REMARKS

Claims 49-111 are pending in the present application. Reconsideration is respectfully requested for the reasons discussed below.

The invention as claimed in this response is based on the surprising discovery that a coating giving outstanding crispness, mouth feel and hold time can be obtained without using cornstarch. Surprisingly, this can be accomplished by using a rice component and a dextrin component in particular ratios and within a particular range.

Thus, the various claims now pending require coating compositions or their use having varying specified quantities and ratios of a rice component and a dextrin component, wherein the composition is "substantially free of cornstarch" (independent claims 49, 92, 111 and 113), or has "about 0% cornstarch" (claim 112), or "is free of cornstarch" (claims 114-117).

The Examiner has rejected claims 49, 92 and 111 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. It is the Examiner's position that, "[i]n claim 49, the language 'substantially free of corn starch' is indefinite because the scope of the claim cannot be ascertained. It is not known how much corn starch can be present and the specification does not define what 'substantially free' mean [sic]. Page 8 of the specification discloses 10% or even more of cornstarch ingredient *may* be used." (Emphasis added)

In traverse of this rejection, Applicants request that the Examiner consider the following two principles of patent law and precedence:

1. Claim terms are to be given their ordinary dictionary meaning unless the specification shows an express intent on the part of the Applicants to impart a novel meaning to the claim terms (*Kegel Co. v. AMF Bowling, Inc.*, 127 F.3d 1420, 44 USPQ2d 1123 (Fed. Cir. 1997); and

2. Terms such as "substantially," "close to," "about," and the like are ubiquitous in patent claims, and have been accepted and upheld by the Courts for purposes of distinguishing the claimed subject matter from the prior art (*Andrew Corp. v. Gabriel Elec., Inc.*, 847 F.2d 819, 6 USPQ2d 2010, 2012 (Fed. Cir. 1988).

As regards the latter function, the United States Supreme Court itself held in *Graham v. John Deere Co.*, 383 U.S. 133, 148 USPQ 459, 473 (1966) that claims "must be read and

interpreted with reference to rejected ones *and to the state of the prior art . . ..*" (Emphasis added)

In the present application, it is manifestly clear that Applicants had no intention of creating a special definition of "substantially free." It is clear that in the present invention as claimed herein, in contrast to the teachings of the prior art, a coating giving outstanding crispness, mouth feel and hold time can be obtained without using cornstarch. While cornstarch "may be" optionally included as noted at page 8 of the specification, it is not necessary.

Accordingly, Applicants are using "substantially free of cornstarch" in the claims in its ordinary dictionary sense, for the purpose suggested by the Federal Circuit in *Andrew Corp. v. Gabriel Elec., Inc.*, and by the United States Supreme Court in *Graham v. John Deere Co.*, to distinguish the prior art, all of which teaches that at least 2.0% cornstarch must be used in order to obtain a food coating made from vegetable and/or cereal materials, and especially coatings for potatoes to be fried.

Applying the above legal principles to this case, one looks first to a dictionary such as Webster's New Collegiate Dictionary, which offers the following pertinent definitions:

> "Free: . . . . 9. Devoid; also, outside; beyond."
> "substantial . . . 5. That is such in substance or *in the main*; as, a substantial victory. (Emphasis added)

Thus the term "substantially free of cornstarch" as used in the claims means that the composition is, "in the main, devoid of cornstarch."

The Federal Circuit Court of Appeals has allowed patentees to use terms such as "substantially free of" because it would be unfair to require a patentee to limit its claims to a composition which is absolutely free of an ingredient, when such a requirement is neither necessary for purposes of operativeness, nor for purposes of distinguishing the prior art. The closest prior art, Horn, discloses a coating which requires 2% or more of cornstarch. The Federal Circuit has recognized that in circumstances such as this, it would be unfair to require Applicants to craft a claim which a competitor could avoid merely by adding an insignificant amount of cornstarch, as for example by using baking powder, which includes a small amount of cornstarch, since the competitor would be getting the benefit of refraining from using 2% or

more of cornstarch, and yet would avoid infringement.

Accordingly, and consistent with prior decisions of the Federal Circuit Court of Appeals and the United States Supreme Court, it is respectfully submitted that "substantially free of cornstarch" meets the definiteness requirements of 35 USC §112. In the context of the present case, it means that the claimed composition is, "in the main, devoid of cornstarch," such that the present claims do not read on Horn et al. which requires at least 2% cornstarch. It is respectfully submitted that the 35 USC §112 rejection on this ground should be withdrawn.

The Examiner has also rejected claims 49-51, 55-57, 61-63, 73-75, 77-79, 81-85, 88-90, 92-98 and 111 under 35 U.S.C. §102(e) as being anticipated by Horn et al. (6,080,434). However, Horn, like other prior art patents disclosing food coatings, requires the use of cornstarch. As noted in the previously submitted Declaration of John Stevens:

> "Considered as a whole, the prior art teaches one of ordinary skill in the art the necessity of using cornstarch in food coatings made from vegetable and/or cereal materials, especially coatings for potatoes to be fried . . . all of the patents listed in the 'background of the invention' of the . . . patent application are directed to food coatings which include cornstarch. To my knowledge, all commercial vegetable and/or cereal based coatings sold prior to the date of this invention, had included cornstarch." (Paragraph 11)

As further noted by Mr. Stevens, the Horn reference is no exception, requiring at least 2% cornstarch. Horn is not "in the main, devoid of cornstarch," as is required by the claims of the present application. Accordingly Horn does not anticipate the claims.

Nor can the Horn patent, which like other prior art vegetable and/or cereal material food coatings teaches the necessity of using cornstarch in the coating, be said to suggest to one of ordinary skill in the art that such coatings can be successfully made which do not require cornstarch. Horn follows the prior art. It is typical of the prior art. It teaches that cornstarch is a required ingredient in such food coatings. In the present invention, it has been found that cornstarch is not necessary, and that successful coatings can be made which are "in the main devoid of cornstarch."

Accordingly, it is respectfully submitted that claims 49-111, as well as new claims 112-117, are not disclosed or suggested by the prior art. Indeed, the prior art teaches away from rice and dextrin food coatings which are substantially free of cornstarch, or which have "about 0 cornstarch," or "which is free of cornstarch."

Applicants also reassert the arguments for patentability of the various claims which were made in the previously submitted response. Further, Applicants traverse and disagree with the Examiner's arguments of obviousness as to the remaining claims of the application. However, in view of the allowability of the independent claims discussed above, Applicants do not believe it is necessary to address these arguments in detail.

Claims 49-111 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner states, "[t]he claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." The Examiner further states, "claims 49, 92, 111 contain the limitation 'substantially free of starches made from plants crossbred or modified to contain either the dull sugary 2 genotype of the amylose extender dull genotype'." It is respectfully submitted that one is not adding new matter to a claim by making it clear that the claim does not cover subject matter which, as is clear from the written description, was never contemplated to be part of the invention. However as has been previously pointed out in paragraph 12 of the Declaration of John Stevens, the starches referred to in the claim clause complained of, as a practical matter can only be cornstarch. (Stevens Declaration, par. 12.) Accordingly, Applicants have removed the language complained of from the claims. Applicants believe this rejection has been overcome.

The Examiner has also taken the position that, "claim 111 is unclear in that it is not known what method Applicants are claiming because the claim only recites 'a method comprising'; a method of what?." Claim 111 has been slightly amended so that the language in question now reads, "[a] method of providing increased surface crispiness to a food substrate comprising the steps of:" Accordingly, claim 111 is believed to be definite and in condition for allowance.

Applicants have made a concerted effort to place the present application in condition for allowance, and a notice to this effect is earnestly solicited. In the event there are any remaining informalities or any other issues regarding Applicants' assistance, Applicants request the Examiner call the undersigned attorney.

Respectfully submitted,

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